

## TRADE NAMES

Words or phrases<sup>1</sup> which have been in common<sup>2</sup> use and which indicate truly the character, kind, quality, or composition of an article of commerce may not be appropriated by any one to his exclusive use.<sup>3</sup> "Whatever is mere description is open to all the world."<sup>4</sup> These words are common property and part of the common stock of the language.<sup>5</sup> Any one may use them to designate a similar article. No manufacturer may impoverish the English language while giving names to his goods. While the court should be swift to prevent the pirating of a tradesman's property, its zeal should not go to the extent of permitting him to appropriate to himself a common word. To allow any other course would be to grant a monopoly in the sale of the goods called by the name, or to forbid a second tradesman to make a correct and truthful designation of his article.<sup>6</sup> No injunction is given against telling the truth<sup>7</sup> and all who may signify a fact with equal truth by the same word symbols have the right to do so.<sup>8</sup> In England descriptive words may be registered in connection with a distinctive device and no right to exclusive use comes therefrom. The fact that the words are "catchy and slangy"

<sup>1</sup> On trade names we may mention the following magazine articles: 30 L. J. 127 (1895), 29 L. J. 154 (1894, 21 Am. L. Reg. N. S. 644 (1882), 22 Am. L. Reg. N. S. 509 (1883), 12 Cent. L. J. 6 (1886), 70 L. T. 148 (1881), 4th Series 23 L. Mag. & Rev. 299 (1898).

<sup>2</sup> *Le Clanche Co. v. Western Co.*, 23 Fed. 276; *Lorillard v. Piper*, 86 Fed. 956; *Sterling Co. v. Spermine Co.*, 112 Fed. 1000; *Noel v. Ellis*, 86 Off. Gaz. 633; *Lewis v. Klapproth*, 11 V. L. R. 214; *Elgin Co. v. Ill. Co.*, (Sup. Ct.) 94 Off. Gaz. 755; *Marshall v. Pinkham*, 52 Wis. 572; *Pace, Talbott & Co. Ex parte*, 16 Off. Gaz. 909; *Pinto v. Trott*, 8 R. P. C. 173; *Slazenger v. Pigott*, 12 R. P. C. 439; *Burton v. Stratton*, 12 Fed. 696; *Searle v. Warner*, 112 Fed. 674.

<sup>3</sup> *Alden v. Gross*, 25 Mo. App. 123; *Caswell v. Davis*, 4 Abb. Pr. N. S. 6; *Helmhold v. Helmhold*, 53 How. Pr. 453.

<sup>4</sup> *Cheavin v. Walker*, 5 Ch. D. 850; *Gilman v. Hunnewell*, 122 Mass. 139, 58 N. Y. 223.

<sup>5</sup> *Peerless Carbon Black Co. Ex parte*, 81 Off. Gaz. 803; *Brennan v. Emory*, 99 Fed. 971, 108 Fed. 624; *Canada Co. v. British Columbia Co.*, 6 B. C. Rep. 377; *Asbestos Co. v. Sclater*, 10 Que. K. B. 165, 18 Que. S. C. 324.

<sup>6</sup> *D. & H. Canal Co. v. Clark*, 1 Off. Gaz. 279; *Town v. Stetson*, 3 Daly 53, 5 Abb. Pr. N. S. 218, Grossmith Re. 6 R. P. C. 180.

<sup>7</sup> *U. S. Co. v. U. S. Co.*, 83 Hun. 572.

<sup>8</sup> *Atkins Re.*, 3 R. P. C. 164.

and do not express the quality in the most grammatical form, does not deprive them of their descriptiveness.<sup>9</sup>

Words which simply indicate the superiority, popularity, or universality in use of the tradesman's goods cannot be exclusively appropriated.<sup>10</sup> The use of such words may facilitate competition, but is not unfair competition.

Descriptive words may be of any part of speech: nouns, verbs, or adjectives.<sup>11</sup> These words are frequently referred to by the courts as "generic terms," because they denote the kind of article on which they are used.

The fact that the claimant of a descriptive word or phrase invented it gives him no right to its exclusive use.<sup>12</sup> Coining a word adds nothing to its value as a trade name. Nor does one gain right to restrain subsequent use by another in good faith from the fact that the former was for a time the only person using the descriptive name.<sup>13</sup> Words which are descriptive can not be good trade names, though they also indicate origin and maker.<sup>14</sup> They must express only the latter, to be distinctive.

A word in common use, taken from the body of the language, cannot be appropriated as a trade name, unless it be applied to an article in an arbitrary and fanciful way, having no natural application to it. The name must not stand for the machine, but for the machine of a particular maker to be considered distinctive.<sup>15</sup>

Where the question of descriptiveness is doubtful, these border line words are usually held to be descriptive in the interests of freedom of trade.<sup>16</sup>

While a descriptive word may not be exclusively appropriated, yet a court will enjoin a person from using the word on goods so

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<sup>9</sup> *Hance Bros., Ex parte*, 87 Off. Gaz. 698.

<sup>10</sup> *Proctor v. Globe Co.*, 92 Fed. 357; *Wolfe v. Burke*, 7 Lansing 151.

<sup>11</sup> *Capital City Co., Ex parte*, 83 Off. Gaz. 295; *Ginter v. Kinney*, 22 Off. Gaz. 770.

<sup>12</sup> *Goodyear Co., Ex parte*, 11 Off. Gaz. 1062; *Cal. Fig Syrup Co. v. Stearns*, 73 Fed. 812.

<sup>13</sup> *Montgomerie v. Donald*, 4 Ct. Ses. Cas. XI, 506, yet the fact that others have used the word for similar products is strong evidence that it is descriptive. *Lewis v. Klapproth*, 11 V. L. R. 214; *Ripley v. Griffiths*, 19 R. P. C. 590. But see *Yorkshire Relish* cases.

<sup>14</sup> *Caswell v. Davis*, 58 N. Y. 223.

<sup>15</sup> *Cooke v. Miller*, 65 N. Y. Supp. 730, 169 N. Y. 475; *Computing Co. v. Standard Co.*, 118 Fed. 965.

<sup>16</sup> *Beadleston v. Cooke*, 76 Off. Gaz. 1576.

as to pass them off for another's and deceive purchasers.<sup>17</sup> You may take advantage of the celebrity of a descriptive name to induce men to buy your goods, if they can be brought to believe that yours are as good as the other trader's, but you must not represent your goods as his, nor deprive him of his legitimate trade by fraud. The fact that the word is an old one gives no more reason for allowing fraudulent use to be made of it than if it were new.<sup>18</sup> A man may tell the truth, but may not practice duplicity in a secondary meaning of the terms he uses.<sup>19</sup>

The burden of proof is upon the plaintiff to show<sup>20</sup> that descriptive words are used by defendants "as, in effect, to represent or to have a tendency to make people suppose that the thing advertised" by them is the plaintiff's article,<sup>21</sup> for an exclusive right to words is more burdensome than one to symbols. In other words, the descriptive word must be shown to have been used by the defendants in a secondary meaning. So *Yorkshire Relish* was protected by the courts when the plaintiff proved that the universal understanding of the public was that the words referred to an article made by him according to a secret process, and a new maker of a compound called by that title was not allowed to use the words even in connection with his own name. The mere fact that some confusion results from the use of the descriptive name by defendant need not be sufficient to cause restraint of such use.<sup>22</sup> But while a tradesman may choose an euphonious word indicating the ingredients of which his product is composed,<sup>23</sup> he may not coin or use a word sufficiently indicative of the quality and character of his article to be invalid as a trademark and sufficiently like another tradesman's name to obtain the benefit of an infringement.

<sup>17</sup> *Lewis v. Klapproth*, 11 V. L. R. 214; *Wolfe v. Alsop*, 12 V. L. R. 421, 887; *Burland Re.*, 6 R. P. C. 482; *Ayer v. Rushton*, 7 Daly 9; *Cal. Fig. Syrup Co. v. Stearns*, 73 Fed. 812; *Randall v. British Shoe Co.*, 19 R. P. C. 393; *Nokes v. Mueller*, 72 Ill. App. 431; *Shaver v. Heller*, 108 Fed. 821; *Meyer v. Bull*, 66 Off. Gaz. 1755; *Moxie Co. v. —*, 43 Off. Gaz. 88; *Sterling Co. v. Spermine Co.*, 112 Fed. 1000.

<sup>18</sup> *Newman v. Alvord*, 49 Barb. 588.

<sup>19</sup> *Army & Navy Soc. v. Army & Navy Civil Service Soc.*, 19 R. P. C. 574; *Dunn Re.*, 7 R. P. C. 311.

<sup>20</sup> *Wilson v. Lyman*, 25 Ont. A. R. 303. (But see *Dunn Re.*, 7 R. F. C. 311.)

<sup>21</sup> *Ill. Watch Co. v. Elgin Co.*, 87 Off. Gaz. 2323; *Powell v. Birmingham Co.*, 12 R. P. C. 496, 11 R. P. C. 563, 13 R. P. C. 235, 1 R. P. C. 1, 720.

<sup>22</sup> *Robinson v. Bogle*, 18 Ont. R. 387.

<sup>23</sup> *Fairbank v. Central Lard Co.*, 70 Off. Gaz. 635.

When a word is once determined to be of a descriptive nature, it does not become distinctive because the definitive article is prefixed to it,<sup>24</sup> nor can that article distinguish two names of articles.<sup>25</sup>

The use of capital letters<sup>26</sup> for syllables or words not usually so written, does not change them from descriptive to distinctive. Nor can there be injunction against a method of pronunciation.<sup>27</sup>

Hyphenation<sup>28</sup> of the syllables of a descriptive word, or of two or more descriptive words, does not make a distinctive trade name. In any case, only a close observer notes such an arrangement.

Equally ineffective is the attempt to turn a descriptive word or phrase into an arbitrary one by printing it in ornamental or in script type, or by placing some flourishes colorably around the descriptive matter.<sup>29</sup> Protection is sought for the words, not for the form in which they appear.

Another ineffective device resorted to by tradesmen to secure distinctiveness for their names is misspelling. When spoken, the words still convey the descriptive idea. Thus Kas-K-Rilla,<sup>30</sup> Kid Nee Kure,<sup>31</sup> Cantripum Clothing,<sup>32</sup> Kleanwell Massage Gloves,<sup>33</sup> are descriptive. So are Uneeda Biscuit<sup>34</sup> and Pirle Clothes (Pearl),<sup>35</sup> which phrase was alleged by the applicant Ripley with what the court called a "rather poor attempt at humor," to be an anagram of his name without the final letter.

<sup>24</sup> *Ex parte Rome Co.*, 91 Off. Gaz. 820; *Re Stapley*, L. R. 29 Ch. D. 877; *Jennings Ex parte*, Newt. Dig. 68.

<sup>25</sup> *Lane v. Smythe*, 46 N. J. Eq. 443.

<sup>26</sup> *Seager Ex parte*, 97 Off. Gaz. 749; *Henderson Ex parte*, 85 Off. Gaz. 453.

<sup>27</sup> *Lecky v. Glover*, 10 R. P. C. 141.

<sup>28</sup> *Seager Ex parte*, 97 Off. Gaz. 749; *Crescent Mfg. Co., Ex parte*, 97 Off. Gaz. 750; *Bronson Ex parte*, 87 Off. Gaz. 1783; *Weil Ex parte*, 84 Off. Gaz. 309; *Pew Ex parte*, Newt. Dig. 103.

<sup>29</sup> *Seager Ex parte*, 97 Off. Gaz. 749; *Miami Co. Ex parte*, 100 Off. Gaz. 1975; *Price Re*, 56 L. R. Ch. 653; *Clement Re*, 16 R. P. C. 611.

<sup>30</sup> *Seager Ex parte*, 97 Off. Gaz. 749.

<sup>31</sup> *Henderson Ex parte*, 85 Off. Gaz. 453.

<sup>32</sup> *Hooker Ex parte*, 108 Off. Gaz. 289.

<sup>33</sup> *Smith Ex parte*, 110 Off. Gaz. 601.

<sup>34</sup> *Uneeda Re*, 1901, 1 Ch. 500; *National Biscuit Co. Re*, 18 R. P. C. 170, 19 R. P. C. 281.

<sup>35</sup> *Ripley Re*, 15 R. P. C. 151.

Spelling a word<sup>36</sup> as it is spelled in a foreign language does not make it distinctive.

When the arrangement of the letters or words in the trader's name is unusual, but the descriptive name plainly appears,<sup>37</sup> he has not succeeded in making a distinctive term.<sup>38</sup> Thus Nevers-Tick Lubricants<sup>39</sup> and Pain-Ease Medicine<sup>40</sup> are not arbitrary. To say a medicine eases a pain is merely to describe, and a "mere reversal of the usual order in which the words are written" does not make them arbitrary.

A syncopation of a descriptive word by omission of a syllable does not make it distinctive.<sup>41</sup>

Writing several words as one does not make them distinctive.<sup>42</sup>

The coupling of words previously used apart, but known to the common or scientific world, gives no right to the exclusive use of the combination. A phrase made up of several descriptive words is no more capable of exclusive possession than are the words which compose it.<sup>43</sup>

Prefixing<sup>44</sup> a proprietor's name to descriptive words does not make the name distinctive.

To show that the word is descriptive, it must appear that the word gives some reasonably accurate information and is a reasonably sufficient description. It need not give a "complete and exhaustive indication of all that the preparation contains," but must be "reasonably indicative," as commonly used by those who understand the meaning.<sup>45</sup>

The use of descriptive words similar to plaintiff's may be evidence tending to show that his distinctive word was deceptively intended.<sup>46</sup>

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<sup>36</sup> *Kipling Ex parte*, 24 Off. Gaz. 898.

<sup>37</sup> *Taber Ex parte*, 96 Off. Gaz. 1036.

<sup>38</sup> *Columbia Co. Ex parte*, 96 Off. Gaz. 1036.

<sup>39</sup> *Woolworth Ex parte*, 100 Off. Gaz. 1976.

<sup>40</sup> *Evans Ex parte*, 96 Off. Gaz. 425.

<sup>41</sup> *Hutchins Ex parte*, 100 Off. Gaz. 1330.

<sup>42</sup> *West Ex parte*, 100 Off. Gaz. 682; *Miller Ex parte*, 95 Off. Gaz. 1452; *Smith Ex parte*, 110 Off. Gaz., 601.

<sup>43</sup> *Caswell v. Davis*, 4 Abb. Pr. N. S. 6, 54 N. Y. 223; *Lawrence Ex parte*, 10 Off. Gaz. 163; *Graham Ex parte*, 2 Off. Gaz. 618.

<sup>44</sup> *Brown v. Meyer*, 31 Fed. 453, 55 Off. Gaz. 287 (U. S. Sup. Ct.).

<sup>45</sup> *Keasbey v. Brooklyn Works*, 142 N. Y. 467; (Acid Phosphate) *Rumford v. Muth*, 35 Fed. 522; (Flaked Oatmeal) *Parsons v. Gillespie*, 15 R. P. C. 57.

<sup>46</sup> *Sterling Co. v. Spermine Co.*, 112 Fed. 1000.

## QUASI DESCRIPTIVE NAMES—COMMON TO THE TRADE.

It sometimes is found that a term which may have been distinctive and even the name of an individual, by long usage as generic, has lost its distinctiveness and has become descriptive of a class of goods.<sup>1</sup> Thus the word Manny<sup>2</sup> was held to have been so applied to a certain kind of harvesters as to have ceased to be registerable as a trademark and to have become *publici juris*. The same rule was held to cover Calhoun plows,<sup>3</sup> Edison phonographs,<sup>4</sup> and Liebig's Extract of Beef.<sup>5</sup> The true test is to decide whether a purchaser of goods, e.g. Barber's Knives, would think he was getting one made by Barber, or one of a certain pattern.<sup>6</sup> In New Zealand it has been held<sup>7</sup> that a well known substance, made under a *publici juris* recipe and sold under a name invented by the first seller and registered as a trademark by him, may be sold under the same name by any other, unless he represents it as a manufacture of the inventor of the name. So Fowler's Solution of Arsenic has gained a so-called generic sense.<sup>8</sup> When the use has been so general that any one may use the word, it is said to be *publici juris*. *Publici juris* words frequently used by tradesmen in a certain line of goods are said to be common to the trade. Of course, the true test<sup>9</sup> is whether the use of the word "has ceased to deceive the public" as to the maker of the article and whether the word is current in the market among those "who are more or less directly connected with the use of the commodity to which the word is applied." Nothing can be common to the trade, which is used by only one person in the trade and surreptitious use can not make a word *publici juris*.<sup>10</sup> "The courts have gone a long way, and with plain justice, in protecting the honest and enterprising manufacturer of any good and useful article from the unscrupulous pirating of his special reputation, but they have been equally careful to prevent any attempted monopoly of that which is common to all."<sup>11</sup> When four men or more were found to have used the same trademark

<sup>1</sup> *Hohner v. Gratz*, 52 Fed. 871.

<sup>2</sup> *Graham Ex parte*, 2 Off. Gaz. 618.

<sup>3</sup> *Hall v. Atkinson*, 13 Off. Gaz. 229.

<sup>4</sup> *Edison v. Hawthorne*, 106 Fed. 173, 108 Fed. 839.

<sup>5</sup> *Liebig & Co. v. Libby*, 103 Fed. 87.

<sup>6</sup> *Barber v. Manico*, 10 R. P. C. 93.

<sup>7</sup> *Marshall v. Hawkins*, 4 N. Z. L. R. S. C. 59, *Cura Clava* medicines.

<sup>8</sup> *Burton v. Stratton*, 12 Fed. 696.

<sup>9</sup> *Stuart v. Scottish, etc., Co.*, 4 Ct. Sess. Cas. XIII—1; *Searle v. Warner*, 112 Fed. 674.

<sup>10</sup> *Thompson v. Montgomery*, 6 R. P. C. 404; *Barlow v. Johnson*, 7 R. P. C. 395.

in England, in 1876, it was held<sup>12</sup> to be common to the trade. The question is to be determined, according to the usage in the forum, and not in some other country, and the word, if *publici juris*, must be known generally to the trade and even to the public; not merely to a few people scattered here and there.<sup>13</sup> The fact that the name was once used by others than the trader who claims it will not make it *publici juris* if it is no longer used by them, but now denotes only the trader's goods.<sup>14</sup> Other examples of terms held *publici juris* are as follows: Imperial, in connection with oysters and probably with candy,<sup>15</sup> Gold Leaf Flour,<sup>16</sup> Victoria Lozenges,<sup>17</sup> Selected Pens,<sup>18</sup> Country Soap,<sup>19</sup> L. L. Sheetings, meaning 4-yard goods,<sup>20</sup> Mandarin Tea,<sup>21</sup> Tycoon Tea,<sup>22</sup> Maizena (in Victoria,<sup>23</sup> and in New South Wales,<sup>24</sup> where use for 25 years was unquestioned by the original owner of the name), S.P. to the snuff trade,<sup>25</sup> Bradshaw's Guide (in New Zealand),<sup>26</sup> *Ne Plus Ultra* in needle trade,<sup>27</sup> Bazaar Patterns,<sup>28</sup> titles of nobility, such as Baron applied to Liebig,<sup>29</sup> Taend Stikker (fire stick) in the match trade,<sup>30</sup> Hunyadi Water,<sup>31</sup> Employer's Liability Insurance,<sup>32</sup> even though plaintiff was the first company in the business.

<sup>11</sup> *Town v. Stetson*, 5 Abb. Pr. N. S. 218.

<sup>12</sup> *Hughes Re*, 10 R. P. C. 369. Where three people use the name and at least two of them innocently, there is no proprietorship in it. *Paine v. Daniell*, 10 R. P. C. 71, 217.

<sup>13</sup> *Hornsby v. Hudson*, 11 N. S. W. L. R. Eq. 148; *Powell v. Birmingham Co.*, 13 R. P. C. 235.

<sup>14</sup> *Symonds v. Greene*, 28 Fed. Rep. 834.

<sup>15</sup> *Whitstable Co. v. Hayling*, 17 R. P. C. 461; *Watson v. Westlake*, 11 Ont. R. 449.

<sup>16</sup> *Partlo v. Todd*, 12 Ont. R. 171.

<sup>17</sup> *Wotherspoon v. Gray*, 3 Ct. Sess. Cas. II—38.

<sup>18</sup> *Mitchell Re*, 1878, W. N. 101.

<sup>19</sup> *Wrigley v. Rouse*, 87 Fed. 589.

<sup>20</sup> *Lawrence Co. v. Tenn. Co.*, 31 Fed. 776, 55 Off. Gaz. 1528.

<sup>21</sup> *British & C. Ass. v. Cooke*, Sebastian, 353, 354.

<sup>22</sup> *Corbin v. Gould*, 51 Off. Gaz. 622.

<sup>23</sup> *National Co. v. Munn*, 13 N. S. W. L. R. Eq. 101.

<sup>24</sup> *National Co. v. Munn*, 11 R. P. C. 281.

<sup>25</sup> *Sales, Pollard & Co., Ex parte*, 25 Sol. J. 833.

<sup>26</sup> *Reid v. Bishop*, 4 N. Z. L. R. S. C. 222.

<sup>27</sup> *Beard v. Turner*, 13 L. T. N. S. 746.

<sup>28</sup> *McCall v. Theal*, 28 Gr. U. C. Ch. 48.

<sup>29</sup> *Liebig v. Anderson*, 1882 W. N. 147; *Anderson Re*, L. R. 26, Ch. D. 409. Possibly Pipers Signal Oil is another example; *Weston v. Ketcham*, 51 How. 455.

<sup>30</sup> *Christiansen Re*, 3 R. P. C. 54.

<sup>31</sup> *Saxlehner v. Eisner*, 88 Fed. Rep. 61, 91 Fed. 531.

<sup>32</sup> *Employers' Corp. v. Employers' Co.*, 24 Abb. Pr. N. C. 368.

## PROPRIETARY NAMES.

Certain words or phrases are so distinctive in their character that they are registrable under the trademark law and become a peculiar property of the tradesman using them, so that the use of them by a rival tradesman is *ipso facto* fraud,<sup>1</sup> even though he associate his name with the trade name. "A purely arbitrary or fanciful appellation, for the first time, used to distinguish an article, to which it has no natural or necessary relation, does, by virtue of that very appropriation and subsequent use, become a trademark."<sup>2</sup> Of course, this right only extends to the use of the name with the particular goods to which it has been applied.<sup>3</sup> The use of the word must be a new one and the article must not be known to the trade by the name claimed as distinctive.<sup>4</sup> The distinctiveness needed is in connection with the class of goods to which the word is applied. A distinctive word is one which operates to show that the goods to which it is applied are different from the similar goods of all other tradesmen. Thus it must indicate origin and ownership and have become, by adoption and use, the proper appellation of the article,<sup>5</sup> for there is no property in any name abstractly considered.<sup>6</sup> If the word be a newly coined one, there is a presumption in favor of its distinctiveness, for such word "brings with it such an element of novelty, as of itself to attract attention," and prevent the confusion of ordinary purchasers of the article.<sup>6a</sup> But whether a new word or not, protection is given<sup>7</sup> whenever there is a new use of a name to distinguish one tradesman's goods from those of others and when the public have generally adopted the name to designate his articles.

<sup>1</sup> *Brennan v. Emery*, 108 Fed. 624; *Burton v. Stratton*, 12 Fed. 696; *Symonds v. Jones*, 82 Me. 302; *Pike Co. v. Cleveland Co.*, 45 Off. Gaz. 947.

<sup>2</sup> *Allegheny Co. v. Woodside*, Fed. Cas. 206; *Falkinburg v. Lucy*, 35 Cal. 52; *Grillon v. Guerin*, 1877 W. N. 14; *Singer v. Wilson*, 3 A. C. 371.

<sup>3</sup> *Rowley v. Houghton*, 2 Brewst. 303.

<sup>4</sup> *Van Bell v. Prescott*, 82 N. Y. 630; *Braham v. Bustard*, 1 H. & M. 447; *Faulder Re*, 18 R. P. C. 37, 535; *Bodega v. Riviere*, 6 R. P. C. 236, 7 R. P. C. 31.

<sup>5</sup> *Ferguson v. Davol Mills*, 2 Brewst 314; *Am. Chem. Co., Ex parte*, 62 Off. Gaz. 588; *Caswell v. Davis*, 4 Abb. Pr. N. S. 6, 58 N. Y. 223; *Celluloid Co. v. Cellonite Co.*, 41 Off. Gaz. 693.

<sup>6</sup> *Wallach v. Wigmore*, 87 Fed. 469.

<sup>6a</sup> *Pa. Co. v. Myers*, 79 Fed. 87.

<sup>7</sup> *Selchow v. Baker*, 11 Daly 353, 93 N. Y. 59.



It is not necessary that the word be impressed on the goods or packages containing them and thus become a trademark,<sup>8</sup> in order to secure it protection from fraud. If distinctive, it may be appropriated as a trade name by use, through word of mouth alone, so as to come to mean the goods of one trader. An arbitrary word is a mere symbol that the goods are made by the tradesman whose labors created them.<sup>9</sup>

In a doubtful case, the fact that the complainant coined the word and was the only person to use it for 40 years, and until defendant began to do so, would turn the scale in the former's favor.

The words which compose a trade name need not be new. If the combination be a new one,<sup>10</sup> which points to the origin and ownership of the goods, it will be unlawful for another tradesman to filch the whole combination or any important part of it.

The defendant's goods, in the absence of patent, may be precisely like the plaintiff's, but the name must not be one calculated to deceive the ordinary purchaser.<sup>11</sup> A distinctive name may belong to the language of the country and be employed rightfully in other connections, but must not be so used as to defraud individuals or deceive the public.<sup>12</sup>

The characteristics of a good trade name<sup>13</sup> are that it has been selected arbitrarily, that it is not expressive of the quality or character of the article, and that it has not previously been appropriated by any other person to designate a similar commodity. Distinctive words denote the manufacture, selection, or other operation done by the user to the goods.<sup>14</sup> They must distinguish article or maker. A name which one has a right to use cannot be registered as part of trademark of another.<sup>15</sup>

When a new article is made, a name must be given it<sup>16</sup> and

<sup>8</sup> *Singer v. Loog*, 8 A. C. 26; *McLean v. Fleming*, 96 U. S. 245.

<sup>9</sup> *Hygeia Co. v. Hygeia Co.*, 70 Conn. 516.

<sup>10</sup> *Wolfe v. Barnett*, 24 La. Ann. 97; *Canterbury Co. v. Christ Church Co.*, 8 N. Z. L. R. 49.

<sup>11</sup> *Comstock v. Morse*, 18 How. Pr. 421; *Sedon v. Senate*, 2 V. & B. 220.

<sup>12</sup> *Matsell v. Flanagan*, 2 Abb. N. S. 459; *Godillot v. Harris*, 81 N. Y. 263.

<sup>13</sup> *Smith v. Sixbury*, 32 N. Y. Sup. Ct. 232.

<sup>14</sup> *Davis Re*, 5 R. P. C. 333.

<sup>15</sup> *Ferne v. Wilson*, 26 Vic. L. R. 422.

<sup>16</sup> *Hostetter v. Fries*, 17 Fed. 621; *Wolfe v. Burke*, 7 Lansing 151; *Searle v. Warner*, 112 Fed. 674.

this name becomes, by common acceptance, the appropriate descriptive term by which it is known, and so is public property. All who have the right to make the article have the right to apply the name to it, provided they do not pass off their goods as another's. Otherwise a person could acquire an exclusive right to a formula by giving a name to an unpatented compound. In considering the name of a medicine, a Federal Court said, "The flowering into popular language of the more or less restricted nomenclature of a useful medical advance cannot thus be imprisoned or cut off."

To prove an exclusive right to a word it must be shown that it is of an arbitrary or fanciful nature<sup>17</sup> or that, being originally descriptive, it has come by use to denote plaintiff's goods. The English cases are especially insistent upon this.<sup>18</sup> "A name should have, to the whole of the trade and to all persons who have any knowledge of the article in question, the sole meaning sought to be attached to it by the plaintiff; that is to say, the original primary meaning must have been eliminated from the dictionary of the persons who deal in this article in the trade and of all other persons whom it may concern to know it. Then the use by another is, necessarily, fraudulent, because the universal signification affects the defendant's mind, as well as the minds of the rest of the persons interested. Where the primary meaning of a suitably descriptive word subsists in trade use,<sup>19</sup> although among a numerically inferior section of a trade, alongside of a secondary meaning in a larger section of that trade, the primary meaning will not be held to be displaced. In other words, to determine whether a word is descriptive or not, "one must not regard it from an etymological point of view, . . . but from the ordinary point of view which would be taken by the ordinary British subject, dealing with the particular goods."<sup>20</sup>

Under the English Trademark Act of 1883, a trade name to be registered<sup>21</sup> must be "a fancy word or words not in common use." This was amended by the act of 1888, so as to read "an invented

<sup>17</sup> *Parsons v. Gillespie*, 15 R. P. C. 57.

<sup>18</sup> *Chivers v. Chivers*, 17 R. P. C. 420; *Ripley v. Griffiths*, 19 R. P. C. 590; *Schove v. Schmincke*, 30 Ch. D. 546.

<sup>19</sup> *Cellular Clothing Co. v. Riley & Maxton*, 15 R. P. C. 581.

<sup>20</sup> *Linotype Co. Re*, 14 R. P. C. 900.

<sup>21</sup> A term may be so descriptive as not to be registered and yet may be capable of appropriation by adoption and user, so as to receive protection by courts against infringement by a rival trader. *Paine v. Daniell*, 10 R. P. C. 71, 217; *Williams v. Mitchell*, 106 Fed. 168; Sebastian, p. 331.

word, or invented words, or a word or words, having no reference to the character or quality of the goods and not being a geographical name." The obvious purpose of these provisions was to prevent the registry of descriptive names, and a number of interesting decisions were made thereunder. It was first supposed that the term fancy word would include any word fancifully applied, which would have been protected under the Common Law.<sup>22</sup> "Where the use of a word not unknown at the time of its first employment is quite different from its ordinary use and the application is so different that it is seen at the first glance that the word is being used quite out of its common signification, where its application is so novel and striking as to be the creation of fancy, it appears to me, that it serves as a mark to distinguish the goods as being the production of a particular manufacturer's just as well in all respects as when the word itself is fanciful." The question is not one of grammar, nor of literary invention, but of trade. The Court of Appeal, however, held that a fancy word was one "which obviously can not have reference to my description, or designation, of where the article is made or what are its characteristics."<sup>23</sup> A fancy word need not be one which cannot be found in the dictionary, but must not properly be applied to the goods<sup>24</sup> so as to "convey any meaning to any ordinary Englishman."<sup>25</sup> It must be so obviously meaningless and inappropriate as neither to be "descriptive, nor deceptive, nor calculated to suggest deception or description," and must further have "an inherent character of fancifulness." This doctrine led to a series of decisions, some of which are ridiculous in the extreme view taken.<sup>26</sup> Sebastian<sup>27</sup> says in only five cases, one of which was afterwards disapproved, was a word upheld as a trademark, while others seem to show a reaction from the extreme view at first taken. The following are examples of the Courts' views: Jubilee note

<sup>22</sup> *Stapley Re*, L. R. 29, Ch. D. 877.

<sup>23</sup> *Van Duzer Re*, 34 Ch. D. 623; *Leaf Re*, 34 Ch. D. 632, 4 R. P. C. 31.

<sup>24</sup> If a word merely "indicates a commendation of the excellence of the article" and does not connect it with any particular maker it is descriptive. *Arbenz Re*, 4 R. P. C. 143.

<sup>25</sup> In a later case, *Davis v. Stribolt*, 6 R. P. C. 207, the court went further and said, "The fact that an ordinary Englishman would not understand the word is no test of fancifulness, for he would not understand many good descriptive words."

<sup>26</sup> A trade name cannot be an ordinary English word, whose application only is fanciful. *Townsend v. Pirie*, 4 R. P. C. 67.

<sup>27</sup> Sebastian, pp. 39 and 40.

paper is "not obviously non-descriptive," but might mean paper made in Victoria's Jubilee Year. Reversi is descriptive of a game of reverses,<sup>28</sup> Red, White and Blue Coffee is not a fancy term,<sup>29</sup> Kokoko meant owl in the Chippewa language and, as a figure of an owl was already registered for cotton goods, the word could not be considered distinctive.<sup>30</sup> If a trade should spring up with the Chippewas, they might become confused between the two makes of goods, as the word and figure were true alternatives in their language. Satinine Starch<sup>31</sup> is made up with "marvellous little invention" and is refused registry as descriptive of the effect of the article, every one knowing that starched goods are glossy. A word was not a fancy word<sup>32</sup> because it denoted a non-existent thing, e.g. Griffin, nor would a Latin termination render a word a fancy one. The word "star" cannot be appropriated,<sup>33</sup> though one may have a "particular phrase in which the word 'star' is used in some special manner, or may have appropriated a particular design in which the figure of a star has assumed some special form."

The change in the law from *fancy* to *invented word* in 1888 made no difference in the rigidity with which the courts interpreted the question of distinctiveness.

Somatose,<sup>34</sup> for an extract of meat, was rejected because of the Greek word, *owux*, from which it was formed, though the court admitted the word gave no clue to the character of the contents of the article. Emolliolorum, from two Latin words, meaning "I soften" and "a strap,"<sup>35</sup> was held to be descriptive of a harness dressing. "It is very possible that an ordinary Englishman would not entirely understand the composition of the word, but, I think," said the Court, "it would convey to his mind the impression that the substance so designated would act, by softening the articles to which it is intended to be applied."

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<sup>28</sup> *Waterman v. Ayres*, 5 R. P. C. 240, 368.

<sup>29</sup> *Hanson Re*, 5 R. P. C. 130.

<sup>30</sup> *Jackson Re*, 5 R. P. C. 180. This decision is questioned in *Denshaw Re*, 12 R. P. C. 75, 271. Romer J. there saying, "I should have been inclined to think that the chance of the Chippewa Indians getting these goods and being deceived was so remote that the Chippewa Indians might have been left to take care of themselves."

<sup>31</sup> *Meyerstein Re*, 7 R. P. C. 114.

<sup>32</sup> *Hodgson v. Sinclair*, 9 R. P. C. 22.

<sup>33</sup> *Dexter Re*, 10 R. P. C. 269.

<sup>34</sup> *Farbenfabriken Re*, 1894—1 Ch. 645.

<sup>35</sup> *Talbot Re*, 11 R. P. C. 77.

None of these cases were taken to the House of Lords, but that body was finally called to decide the question of descriptiveness in the case of the invented word *Solio*, used in reference to photographic paper.<sup>36</sup> The decision was then made that the word should be registered. Lord Macnaghten said, "It is no objection to an invented word, that it may be traced to a foreign source, or that it may contain a covert allusion to the character or quality of the goods. It need not be wholly meaningless. A word is invented which has never been used before and does not readily convey to most people a particular meaning." *Solio* might be derived from *sol* (the sun), *solum* (the earth), or *solium* (a throne). This doubt practically showed that the word is invented. "The quantum of invention," Lord Herschell added, "is immaterial." Registry is not allowed as a reward of merit, but because no one is deprived of the right to use the previously existing vocabulary. Since the *Solio* case, the courts have been more ready to protect words as invented. In upholding the claims of *tachy-type* for registry,<sup>37</sup> the Judge said that an invented word need not be invented by the applicants, nor need there have been any prior publication of it in the jurisdiction. It may even have reference to the character or quality of the goods, if none but a scholar would know what the word means.

The effect of the earlier cases, refusing registry to trade names, was much diminished by the decisions in the *Camels' Hair Belting Case*, in which protection was given to those words and the basis of the court's action placed on the broad ground of passing off and fraud.<sup>38</sup> In the first of these cases, in which plaintiff's goods were chiefly made of sheep and goats' hair and defendant's goods contained no camels' hair, the court said that the name may be used by any one, if it denotes a particular kind of belting, but that it was a proprietary name, if it denoted belting made only by the plaintiffs. As the defendant used the name fraudulently, he was enjoined.

In the second and more important case,<sup>39</sup> a jury in the Queen's Bench Division found that the defendant was passing off goods

<sup>36</sup> *Eastman Co. Re*, 15 R. P. C. 476, 1898 A. C. 571.

<sup>37</sup> *Linotype Co. Re*, 17 R. P. C. 380; *Cellular Co. v. Maxton*, 15 R. P. C. 581, 16 R. P. C. 397. An invented name has either no meaning at all, or none in relation to the goods it denotes.

<sup>38</sup> *Reddaway v. Bentham*, 9 R. P. C. 503.

<sup>39</sup> *Reddaway v. Bentham*, 12 R. P. C. 83, 13 R. P. C. 218. See *Hall v. Barrows*, 10 Jur. N. S. 55.

and leading purchasers to think that his goods were the plaintiff's by calling them Camels' Hair Belting, which term was equivalent in meaning to Reddaway's Belting. The Court of Appeal reversed this decision, on the ground that Banham properly described his belting by the term, as his goods were made of camels' hair, but the House of Lords, on further appeal, restored the Queen's Bench decision, holding that when words, which are descriptive of an article, have come to denote the goods of a particular trader, he is entitled to restrain others from using them so as to deceive. If the public can be deceived by Banham's calling his goods Camel's Hair Belting, there must be some fallacy in saying that he has told the simple truth. "The fallacy lies in overlooking the fact, that a word may acquire in a trade a secondary signification," and then is no less a falsehood in that trade, because of the fact that, in its primary sense, it may be true. The falsehood lies in using language which conveys a false idea and, while one tradesman may not restrain another from the use of a common English word, he may insist that it shall not be used without qualification, if such use would lead to fraud. Since the decision in *Reddaway v. Benthams*, in which decision, curiously enough, no allusion was made to the question of deceptiveness, it had been discovered that Reddaway's Camels' Hair Belting was really made of such hair. This does not end the case by showing that the words are merely descriptive. It is rash to say, *a priori*, how far a term is descriptive, without being familiar with the use of the trade, and if the name was primarily descriptive, but has come to be understood to mean the manufacture of a particular maker, a second maker may not use that name, for the effect of that use will be to pass off the latter's goods for the former's, by means of the duplicity in the trade name and to make them salable because they bear the former's trade name.

In two later decisions,<sup>40</sup> Belting of Camels' Hair and Karmal Belting were held to infringe Camels' Hair Belting. The latter might not deceive in England, but would be apt to do so in India, where Reddaway had a large trade.

It was feared by many that this decision went so far that the use of descriptive names would be seriously interfered with, but the House of Lords, in the *Cellular Clothing Case*,<sup>41</sup> affirming the

<sup>40</sup> *Reddaway v. Ahlers*, 19 R. P. C. 12; *Reddaway v. Frictionless Co.*, 19 R. P. C. 505.

<sup>41</sup> *Cellular Clothing Co. v. Maxton*, 15 R. P. C. 588, 16 R. P. C. 397. (See *Burgess v. Burgess*, 17 Eng. Z. and Eq. Rep. 257.)

decision below, carefully explained the effect of the *Camels' Hair Belting Case*. The plaintiff is bound to establish that the technical and secondary meaning is such as to exclude every one else from using the word. This is a matter of fact, and not of law, and was established in *Reddaway v. Banham*. If the defendant shows that his name properly describes the goods, the plaintiff must then show that it no longer means only what it says, but has acquired a secondary and further meaning. The utmost difficulty should be put in the plaintiff's way, as to give him an exclusive right to descriptive words, confers on him a more valuable privilege than a patent right. Chief Justice Fuller, in the Supreme Court of the United States, commenting on the *Reddaway*<sup>42</sup> and the *Singer*<sup>43</sup> Cases, said that they "do not sustain the proposition, that words, which in their primary signification give notice of a general fact and may be used for that purpose by every one, can lawfully be withdrawn from common use in that sense, but they illustrate the adequacy of the protection from imposition and fraud, in respect of a secondary signification, afforded by the courts. . . . There may be such circumstances that subsequent users are bound to distinguish their merchandise, and may be restrained unless they couple with the use of the generic name, some caution suitable to guard the public from confusing the sources of production."

In the United States, words originally descriptive in character, especially when used in connection with a symbol, have been held to be entitled to legal protection, when by long use the secondary meaning, identifying the goods as the particular preparation of the tradesman,<sup>44</sup> has become understood by the general public, as the natural meaning of the words.<sup>45</sup> The name may contain certain elements of description, but the "originator is entitled to certain proprietary rights in a name, which he has used to designate a certain article and for which he has built up a reputation."<sup>46</sup> The most important question with distinctive names is whether the public will be deceived<sup>47</sup> and one tradesman's goods passed off as another's by the mere use of the word. One who has chosen a

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<sup>42</sup> *Elgin Co. v. Ill. Co.*, 94 Off. Gaz. 755. See *Dadirrian v. Yacubian*, 98 Fed. 872.

<sup>43</sup> \_\_\_\_\_

<sup>44</sup> *Heyman Ex parte*, 18 Off. Gaz. 922; *Wells v. Siegel*, 106 Fed. 77 (Celery Compound); *Mark Cross Co., Ex parte*, 102 Off. Gaz. 623.

<sup>45</sup> So in Canada, *Provident Works v. Canada Co.*, 2 O. L. R. 182.

<sup>46</sup> *Noel v. Ellis*, 86 Off. Gaz. 633.

<sup>47</sup> *Barber v. Manico*, 10 R. P. C. 93.

trade name is entitled to be protected against another <sup>48</sup> who seeks to trade upon the reputation of his goods, but the word must be used by one who deals in the article and it must indicate that the article is his.<sup>49</sup> While it is especially important that the names be different, if the goods are very similar in appearance,<sup>50</sup> yet it is no defense that the defendant does not dress up his goods like plaintiff's. He must not use a name similar to one which "has been so identified with the business of a manufacturer, as to inform the public that it means his product."<sup>51</sup> The courts frown on all "filching attempts" to obtain another's reputation, and it may well be that a thing is known to people by a "particular name, without its being known to them" who is the tradesman whose goods are denoted thereby.<sup>52</sup> It is essential, however, to show that the public understanding is clear respecting the use of the word, before it will be protected as a proprietary one.<sup>53</sup> In an early case <sup>54</sup> in England where two men, neither of them the inventor, claimed the right to sell Dr. Johnson's Yellow Ointment, Lord Mansfield held that, as neither person has proven property to the recipe, as the defendant had not sold his goods as those of the plaintiff, and as the plaintiff did not use his own name, but that of the inventor with the goods, no remedy should be given.

The mere fact that the word chosen carries with it a claim of excellence does not indicate the choice of a word as arbitrary,<sup>55</sup> if the word is not a mere term of quality. "By close analysis and ingenuity, you can find in almost any trade name a designation of some quality connected with the goods," but this fact does not make the name a descriptive one.<sup>56</sup>

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<sup>48</sup> *Gaines v. Leslie*, 54 N. Y. Supp. 421; *Plant Co. v. May Co.*, 105 Fed. 375.

<sup>49</sup> *Formalin Co. Re*, 17 R. P. C. 486.

<sup>50</sup> *Wolfe v. Nopitsch*, 18 R. P. C. 27.

<sup>51</sup> *Fuller v. Huff*, 92 Off. Gaz. 1620.

<sup>52</sup> *Bewlay v. Hughes*, 15 R. P. C. 290.

<sup>53</sup> *Kohler v. Beshore*, 62 Off. Gaz. 592.

<sup>54</sup> *Singleton v. Bolton*, 3 Doug. 293.

<sup>55</sup> *Plant Co. v. May Co.*, 105 Fed. 375.

<sup>56</sup> *Roberts v. Sheldon*, 18 Off. Gaz. 1277; *Du Boulay v. Du Boulay*, 17 W. R. 594.



